



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re application of:
Walker, et al.

Serial No.: 09/668,831

Filed: September 22, 2000

For: CORDLESS SURGICAL
HANDPIECE WITH DISPOSABLE
BATTERY AND METHOD

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Attorney Docket No.: 31849.24

Customer No.: 27683

Group Art Unit: 3731

Examiner: Davis, Daniel J.

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TECHNOLOGY CENTER R3700

REQUEST TO REMOVE FINALITY OF OFFICE ACTION & RESPONSE TO OFFICE ACTION

BOX AF
Commissioner For Patents
Washington, D.C. 20231

Dear Examiner:

In response to the telephone interview of April 23, 2004 between the Examiner and the Applicant's attorney, in which the Examiner agreed to withdraw the finality of the Office Action of February 6, 2003, please consider the following request and remarks:

REQUEST & REMARKS

Claims 1-12 are pending in the application. Affirmation of Examiner's agreement to withdraw the finality of the Office Action of February 6, 2003 is requested. Additionally, reconsideration and allowance of claims 1-12 are requested in light of the following remarks.

Finality of Office Action

The Application stands rejected by a Final Office Action mailed February 6, 2003, and further, the Applicant is in receipt of the Advisory Action mailed April 8, 2003. As the PTO provides in MPEP §706.07(a), "second or any subsequent actions on the merits shall be final, *except* where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement (IDS)" (emphasis added). It is submitted that the Final Office Action has introduced a new ground for rejection that is not necessitated by either Applicant's amendment or information submitted in an IDS. In the first Office Action mailed September 27, 2002, claims 3-12 were rejected *solely* on the basis of the judicially created doctrine of obviousness-type double patenting. Without having been amended, claims 3-12 were later rejected by the Final Office Action under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,368,954 to